IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: §   Group Art Unit: 2187

     Michael S. Bender, et al.   §

          §   Examiner: Farrokh, Hashem

Serial No. 10/780,270   §

          §   Atty. Dkt. No.: 5681-76100

Filed: February 17, 2004   §

          §

For: System and Method for   §

      Accessing Storage Devices   §

      Attached to a Stateless Client   §

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

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Commissioner for Patents
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Sir/Madam:

In response to the Decision on Appeal rendered November 5, 2009 (hereinafter Decision), Appellants present this Request for Rehearing under 37 C.F.R. § 41.52. Appellants respectfully request that the Board of Patent Appeals and Interferences consider this request in view of the following remarks.

INTRODUCTION

Appellants' claim 1 is directed to a system that includes a server and a stateless client. Appeal Brief at 19. The server is configured to execute an application. *Id.* The stateless client is configured to communicate with the server, and further configured such that during use, a user interacts with the application via the stateless client. *Id.* The recited system further includes a mass storage device locally coupled to the stateless client, wherein the mass storage device is accessible by the user via the server. *Id.* The server is further configured to store data to the mass storage device via the stateless client in response to the user's interaction with the application. *Id.*

Thus, according to the features of claim 1, data is stored to a mass storage device that is locally coupled to the stateless client. However, claim 1 specifically recites that it is the server that stores data to the mass storage device via the stateless client, and further recites that the data storage by the server occurs in response to user interaction with an application that the server is configured to execute. That is, in contrast to the stateless client autonomously storing data to a locally coupled mass storage device, claim 1 specifically recites that a server distinct from the stateless client is configured to store the data to the mass storage device, and to do so under specifically recited conditions.

In its decision, the Board affirms the rejection of claim 1 as being anticipated by Billington (U.S. Patent No. 7,103,760) (hereinafter Billington). Decision at 9-10. However, the Board's decision is contrary to Federal Circuit precedent, in that it fails to demonstrate that all of the elements of claim 1, <u>arranged as recited in claim 1</u>, may be found in Billington, as required by *Net MoneyIN, Inc. v. Verisign, Inc.* Further, the Board's decision is grounded in an erroneous finding of fact that, by misquoting Billington, attributes a feature to Billington that Billington does not in fact disclose. Accordingly, as established below, Appellants submit that the Board's decision is contrary to both the facts of this case and relevant law.

ARGUMENT

Appellants respectfully submit that the Board's decision misapprehends or overlooks the following points.

1. The Board's position that Billington discloses a mass storage device accessible by a user via a server, where the mass storage device is locally coupled to a stateless client that communicates with the server, and where the user interacts with an application that the server is configured to execute, is <u>contrary to Federal Circuit precedent</u>.

Appellants have previously noted that claim 1 explicitly recites a number of interrelationships among its various features. *See, e.g.*, Reply Brief at 3-4. That is, claim 1 does not merely recite a server, a stateless client, a mass storage device, and a user. Rather, claim 1 explicitly recites that the user interacts with the application <u>via the stateless client</u>, and that the application is executed <u>by the server</u>. Moreover, the mass storage device is <u>locally coupled to</u> the stateless client, and is accessible by the user <u>via the server</u>.

In its decision, the Board finds that "Billington's disclosure teaches that the thin client device may access the mass storage device via the processor. In particular, . . . Billington's disclosure of a user associated with the thin client device accessing the mass storage device via the processor teaches the 'mass storage device is accessible by said user via said server'" feature of claim 1. Decision at 10. Appellants respectfully submit that this finding is mistaken for at least the following reasons.

A.   Contrary to the Federal Circuit's requirement in Net MoneyIN, *the Board's analysis fails to demonstrate that Billington discloses the <u>specific arrangement</u> of elements recited in claim 1.*

Preliminarily, Appellants note that 37 C.F.R. § 41.52(a)(2) states that "[u]pon showing of good cause, appellant may present a new argument based upon a recent relevant decision of . . . a Federal Court." Appellants note that, as discussed in greater detail below, the Federal Circuit's decision in *Net MoneyIN* is squarely on point with respect to issues in this appeal. Moreover, *Net MoneyIN* was decided on October 20, 2008. Because Appellants filed their Reply Brief on March 7, 2008, Appellants could not have earlier presented an argument based on *Net MoneyIN*. Accordingly, Appellants submit that these facts show good cause as to why the Board should consider the following argument.

The Federal Circuit has clearly and recently articulated that to demonstrate anticipation, it is insufficient to merely demonstrate "that the four corners of a single, prior art document describe every element of the claimed invention." *Net MoneyIN, Inc. v. Verisign, Inc.*, 454 F.3d 1359, 1369 (Fed. Cir. 2008) (internal citations omitted). Rather, the reference "must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements arranged as in the claim." *Id.* (internal citations omitted). Treating the claims "as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning," will not sustain an argument of anticipation. *Id.* at 1370 (internal citations omitted).

In *Net MoneyIN*, the claim in question disclosed a number of "links" between a number of computer systems, the links being adapted for performing various specifically recited activities with respect to those computer systems in order to process credit card transactions. *Id.* at 1368-69. The allegedly anticipating reference disclosed separate protocols for processing credit card transactions. However, the Federal Circuit concluded that "[n]either of these protocols contains all five links arranged or combined in the same

way as claimed," and therefore the reference could not anticipate the disputed claim. *Id.* at 1371.

The Board's analysis of pending claim 1 resembles the lower court decision reversed by the Federal Circuit in *Net MoneyIN*. In particular, the Board's analysis quoted above appears to identify Billington's processor with the recited server. However, claim 1 specifically recites that the server is configured to execute an application, and that the user interacts with the application via the stateless client. That is, for Billington's mass storage device, thin client, and processor to be "arranged as in" claim 1, the Board would need to establish not only that these elements correspond to the elements of claim 1, but that they interact in the same way as the elements of claim 1.

However, the Board's decision fails to address the interrelationships recited among the elements of claim 1. In particular, the Board's analysis quotes as the "relevant parts" only portions of the final two clauses of claim 1, suggesting that the omitted parts are not relevant. Decision at 9. But in failing to consider the relationship of the quoted features to the omitted features, the Board's analysis "disregard[s] the part-to-part relationships set forth in the claims" in precisely the manner that the Federal Circuit faulted in *Net MoneyIN*.

Moreover, Appellants submit that as argued in the Appeal and Reply Briefs, the recited interrelationships simply cannot be found in Billington. That is, Billington fails to disclose a server configured to execute an application, a stateless client configured such that during use, a user interacts with the application via the stateless client, and a mass storage device locally coupled to the stateless client and accessible by the user via the server. Although Billington discloses a mass storage device coupled to a thin client, it is entirely conceivable that in Billington's system, the thin client autonomously interacts with the mass storage device without the involvement of a server. But this operation would run counter to the requirement of claim 1 that the mass storage device is accessible by the user via a server.

B. *In attempting to find anticipation, the Board's analysis impermissibly combines distinct embodiments of Billington.*

In its decision, the Board relies on two distinct findings of fact, FF 1 and FF 2, in concluding that Billington discloses that a "mass storage device is accessible by said user via said server." Decision at 9-10. FF 1 refers to the embodiment of Billington discussed at col. 14 as disclosing a system that "enables numerous thin clients to share the resources of one powerful PC." *Id.* at 5 (quoting Billington at col. 14, ll. 12-16). FF 2 refers to the embodiment of Billington discussed at col. 11 as disclosing "that a number of devices can be conveniently connected to the processor at the desktop location of the peripheral, rather than at the processor such as a PC. *Id.* (citing Billington at col. 11, ll.25-28).

In *Net MoneyIN*, the Federal Circuit held that a lower court was "wrong to combine parts of the separate protocols" shown in the prior art reference in attempting to establish anticipation. *Net MoneyIN*, 545 F.3d at 1371. "It is not enough that the prior art reference . . . includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention." *Id.* "[T]he [prior art] reference must . . . direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *Id.* (internal citations omitted).

Appellants note that the embodiment of Billington cited at col. 11 is described with respect to FIG. 4 as "another embodiment [in which] the peripheral device 12 can comprise a printer having further devices 39a, 39b incorporated in the case 32." Billington at col. 11, ll.17-19. By contrast, the embodiment of Billington cited at col. 14 is described with respect to FIG. 11 as an embodiment in which "the peripheral 12 can comprise a thin client device connectable to user interface devices." *Id.* at col. 14, ll.21-23. That is, these two portions of Billington describe completely different embodiments of Billington's peripheral device 12 as either a printer or a thin client device.

Billington fails to describe how the features of the printer embodiment are applicable to the thin client device embodiment. Accordingly, Appellants submit that the Board's reliance on FF 1 and FF 2 impermissibly combines distinct embodiments in a manner similar to the approach the Federal Circuit rejected in *Net MoneyIN*.

This analysis also demonstrates lack of support for the Board's conclusion that "Billington discloses that the thin client device connects to the data storage device or mass storage device either via the processor or peer-to-peer." Decision at 9-10. Billington describes this connection "via the processor or peer-to-peer" with respect to the embodiment at col. 11, which pertains to a <u>printer</u>. However, as noted above, Billington's <u>thin client</u> embodiment is completely distinct from Billington's <u>printer</u> embodiment. Therefore, it simply does not follow that features disclosed with respect to Billington's printer embodiment are features of the thin client, as the Board incorrectly concludes.

2. The Board's position that Billington discloses a server configured to store data to a mass storage device via a stateless client in response to the user's interaction with an application is grounded in an <u>erroneous finding of fact</u>.

In addition to the features discussed above, pending claim 1 recites "wherein said server is further configured to store data to said mass storage device via said stateless client in response to said user's interaction with said application." Appeal Brief at 19. Appellants note that the arguments given above with respect to interrelationships among elements of claim 1 also apply to this feature. That is, the server, application, mass storage device, and stateless client of Appellants' claim are related in a particular manner. According to the principles of law discussed above with respect to *Net MoneyIN*, in addition to the elements themselves, the specifically recited relationships among elements must be found within the allegedly anticipating reference.

In its analysis, the Board addresses the above-quoted feature by referring to FF 1 and stating that "Billington discloses that numerous thin client devices share the

resources of the processor, the use of drivers, one or more printers, scanners, etc." Decision at 10. The Board then "find[s] that the thin client devices share one common processor and its associated driver software." *Id.* **However, this finding of fact is flawed by the Board's misquoting of Billington's disclosure.** FF 1 quotes from Billington at col. 14, ll. 12-16. Decision at 5. This portion of Billington states that thin clients may "share the use of ***drives***, one or more printers, scanners, etc." Billington at col. 14, ll. 15-16 (emphasis added). That is, Billington describes the sharing of <u>drives</u>—a hardware device—and not the sharing of a <u>software driver</u>. In fact, nowhere within the bounds of its disclosure does Billington use the term "driver" or "driver software," much less describe the sharing of such software by thin clients.

The Board's conclusion that Billington discloses a server configured to store data via a stateless client in response to a user's interaction with an application executed by the server is bottomed in the Board's finding that Billington discloses "the thin client devices sharing one common processor and its associated driver software." However, as noted above, Billington does not make such a disclosure. Thus, the Board's conclusion is factually unsupported.

Moreover, as noted at length by Appellants in the Reply Brief, Billington simply fails to disclose any particular details regarding the specific manner by which data is stored to a mass storage device coupled to a thin client. To anticipate claim 1, Billington must show nothing less than a server configured to store data to a mass storage device via a stateless client in response to a user's interaction with an application <u>that executes on the server</u>, and where the mass storage device is locally coupled to the stateless client.

Billington does not do so. As noted above, Billington discloses a mass storage device coupled to a thin client. However, in the absence of any detailed disclosure by Billington as to how the mass storage device and thin client interact, it is certainly possible that Billington's <u>thin client itself</u> controls and manages access to the mass storage device, as would be the case with any peripheral device locally coupled to a client system. Regardless, no aspect of Billington's disclosed arrangement of a thin client and a

mass storage device suggests that a <u>server</u> distinct from the thin client stores data to the mass storage device in response to user interaction with an application that executes on the server. As noted above, it is conceivable that Billington's thin client autonomously interacts with the mass storage device without the involvement of a server. In contrast, claim 1 requires that the <u>server</u> store data to the mass storage device <u>via</u> the stateless client in response to the user's interaction with the application executing on the server.

Arguments similar to those given above also apply to similar independent claims 8 and 15.

For the foregoing reasons, it is submitted that the Board's decision affirming the rejection of independent claims 1, 8, and 15 as anticipated by Billington is unsupported by the facts and is contrary to Federal Circuit precedent.

CONCLUSION

For the foregoing reasons, Appellants respectfully request that the Board reconsider its decision on appeal for the present application and reverse the Examiner's rejection.

The Commissioner is authorized to charge any fees that may be due to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5861-76100/RCK.

Respectfully submitted,

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